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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,125	04/10/2002	Shogo Ishioka	011714	6856
38834	7590	07/05/2006	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			SHEIKH, ASFAND M	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/030,125	Applicant(s) ISHIOKA ET AL.	
	Examiner Asfand M. Sheikh	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 11-17, 20-26 and 29-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 18, 19, 27, and 28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In responsive Remarks/Arguments filed on 28 April 2006:

Claims 1-38 are pending in the present application. Claims 1, 4-10, 18, 19, 27, and 28 are amended and Claims 11-17, 20-26, and 29-38 are withdrawn.

The Examiner withdraws Specification Objection.

The Examiner withdraws the 35 U.S.C § 112 rejections.

The Examiner maintains the same ground of rejection, 35 U.S.C § 103, as in the previous action, for Claims 1-8, 10, 18, 19, 27 and 28. The Examiner establishes new grounds of rejection for Claim 9, in light of the addition of newly amended limitations.

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-2, 5-10, 18 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. U.S. Pat. 5,694,551 (hereinafter Doyle) in view of Jardin U.S. Pat. 6,681,327 (hereinafter Jardin).

As per claims 1, 18, and 27, Doyle discloses a first computer available for a client intending to make a request for supplying an inspection apparatus used for a circuit board (col. 2, lines 50-54; Fig. 2), a second computer available for a plurality of dealers including a first dealer intending to provide a circuit-board inspection apparatus or a component of a circuit board inspection apparatuses (col.2, lines 54-57; Fig. 2), a third computer capable of communicating with said first computer and said second computer via a communication line, said third

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computer being adapted to receive said request from first computer (col. 2, lines 38-49; Fig. 2)

Doyle fails to explicitly disclose means for receiving a board-specification information defining a specification of said circuit board from said first computer, means for providing said received board-specification information to said second computer, means for receiving a product information from a second computer, said product information defining the circuit-board inspection apparatus of the component of circuit-board inspection apparatuses which is prepared for said board-specification information and is providable from said first dealer, and means for providing said received product information to said first computer.

However Jardin discloses means for receiving a board-specification information defining a specification of said circuit board from said first computer (col. 7, lines 57-61), means for providing said received board-specification information to said second computer (col. 7, lines 61-63), means for receiving a product information from said second computer, said product information defining the circuit-board inspection apparatus of the component of circuit-board inspection apparatuses which is prepared for said

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board-specification information and is providable from said first dealer (col. 8, lines 6-11), and means for providing said received product information to said first computer (col. 8, lines 11-15).

It would be obvious to one skilled in the art at the time the invention was made to modify Doyle's method to include a means for receiving a board-specification information defining a specification of said circuit board from said first computer, means for providing said received board-specification information to said second computer, means for receiving a product information from said second computer, said product information defining the circuit-board inspection apparatus of the component of circuit-board inspection apparatuses which is prepared for said board-specification information and is providable from said first dealer, and means for providing said received product information to said first computer as taught by Jardin. The motivation to combine would provide communication technology to support the brokering of client transactions over a communication network and help aid in eliminating server bottlenecks based off of those client transactions over that communication network (col. 2, lines 49-53).

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As per claim 2, Doyle discloses means for receiving an order of the circuit-board inspection apparatus or the component of circuit-board inspection apparatuses from said first computer, said circuit-board inspection apparatus or the component being selected by said client according to said product information (col. 4, lines 35-37; Fig. 6) and means for notifying the receipt of said order to said second computer according to the content of said received order (col. 6, lines 45-54).

As per claim 5, Doyle discloses wherein said third computer includes a dealer database storing a dealer information defining for each of said dealers (col. 3, lines 8-17 and col. 8, lines 47-53; Fig. 3).

As per claim 6, Doyle discloses wherein said dealer information includes a contact address, size, transaction record, product list, and trouble in transaction of said dealers (col. 8, lines 47-60; Examiner interprets that any information relevant to a dealer can be maintained on any database; Examiner also interprets that this is non-function descriptive material pertaining to a information service system).

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As per claim 7, Doyle discloses wherein said third computer includes a client database storing a client information defining said client (col. 3, lines 8-17; Fig 3).

As per claim 8, Doyle discloses wherein said client information includes a contact address, request history, content of equipment owned by said client, and troubles in dealing of said client (col. 3, lines 24-33; Examiner interprets that any information relevant to a customer can be maintained on any database; Examiner also interprets that this is non-function descriptive material pertaining to a information service system).

As per claim 10, Doyle discloses a means for producing a management table for said request when said board-specification information is received; and means for storing said management table in association with said board-specification information (col 3, lines 24-33; Examiner interprets that "requisitions" would contain information relevant to a given request); wherein said management table comprises information corresponding to said board specification information (col. 3, lines 8-23;

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Examiner interprets "master product catalog, general reference information such as product class, codes, and product groups..." would be information corresponding to said board specification information).

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3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. U.S. Pat. 5,694,551 (hereinafter Doyle) in view of Jardin U.S. Pat. 6,681,327 (hereinafter Jardin) as applied to claim 1 above, and further in view of Business Wire, "*Minolta Peripheral Products Division Goes Extra Mile for Resellers and End Users With New Service Programs*" (hereinafter Business Wire).

As per claim 3, Doyle fails to explicitly disclose wherein said second computer is available for a second dealer intending to provide an after-sale service of circuit board inspection apparatuses or components wherein said third computer includes means for receiving a demand of said client for an after sale service from said first computer, said after-sale service relating to said circuit-board inspection apparatus or said component of inspection apparatuses which as been purchased by said client from said first dealer and means for notifying said received demand to said second computer available for said first dealer who has sold said circuit-board inspection apparatus or said component or circuit-circuit board inspection

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apparatuses, or for said second dealer intending to provide said after-sale service.

However Jardin discloses means for receiving a demand and a means for notifying said received demand (col. 4, lines 1-24, col. 7, lines 57-63, col. 8, lines 6-15; Examiner interprets that "receiving" and "notifying" is based on which computer needs to receive or notify information. This is all done via the third computer, which brokers these transactions).

It would be obvious to one skilled in the art at the time the invention was made to modify Doyle's method to include for receiving a demand and a means for notifying said received demand as taught by Jardin. The motivation is the same as claim 1 above.

Doyle and Jardin fail to explicitly disclose an after-sale service. Business Wire discloses an after-sale service (Section A; Examiner interprets "Internet-based warranty claim" to be an after-sale service that can be requested via a client computer).

It would be obvious to one skilled in the art at the time the invention was made to modify Doyle and Jardin's method to an after-sale service as taught by Business Wire. The motivation to combine would provide a total business

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solution and a higher level of customer service, which would both help create a stronger reputation and image for a given company.

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4. Claims 4 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. U.S. Pat. 5,694,551 (hereinafter Doyle) in view of Jardin U.S. Pat. 6,681,327 (hereinafter Jardin) as applied to claim 1 above, and further in view of Cameron et al. U.S. Pat. 5,592,378 (hereinafter Cameron)

As per claim 4, Doyle and Jardin both fail to explicitly disclose means for receiving from said first computer at least either one of a desired delivery date of the circuit-board inspection apparatus, a desired cost of the circuit-board inspection apparatus, and an equipment information defining a circuit-board inspection equipment owned by said client and means for producing the product information prepared for said delivery date, said cost, and said equipment information to said first computer.

However Cameron discloses means for receiving from said first computer at least either one of a desired delivery date of the circuit-board inspection apparatus, a desired cost of the circuit-board inspection apparatus, and an equipment information defining a circuit-board inspection equipment owned by said client (col. 6, lines 29-37 and col. 9, lines 22-34) and means for producing the

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product information prepared for said delivery date, said cost, and said equipment information to said first computer (col. 6, lines 29-37 and col. 9, lines 22-34).

It would be obvious to one skilled in the art at the time the invention was made to modify Doyle and Jardin's method to include means for receiving from said first computer at least either one of a desired delivery date of the circuit-board inspection apparatus, a desired cost of the circuit-board inspection apparatus, and an equipment information defining a circuit-board inspection equipment owned by said client and means for producing the product information prepared for said delivery date, said cost, and said equipment information to said first computer as taught by Cameron. The motivation to combine would customer driven entry system that permits placement of an order in a timely and efficient manner and provides for the normalization of data in order to limit redundancies of data and for access to a variety of database management systems (col. 2, lines 28-25).

As per claim 19, Doyle and Jardin both fail to explicitly disclose wherein said product information

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includes at least either one of a cost, delivery date, and available number for sale of said circuit board.

However Cameron discloses wherein said product information includes at least either one of a cost, delivery date, and available number for sale of said circuit board (col. 6, lines 29-37 and col. 9, lines 22-34).

It would be obvious to one skilled in the art at the time the invention was made to modify Doyle and Jardin's method to include discloses wherein said product information includes at least either one of a cost, delivery date, and available number for sale of said circuit board as taught by Cameron. The motivation to combine is the same as claim 4 above.

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5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. U.S. Pat. 5,694,551 (hereinafter Doyle) in view of Jardin U.S. Pat. 6,681,327 (hereinafter Jardin) as applied to claim 1 above, and further in view of Singh United States Patent Application Publication 2001/0047311.

As per claim 9, Doyle and Jardin both fail to explicitly disclose said third computer includes a dealer database storing dealer information defined for each of said dealers, said third computer determines said first dealer should receive the board specification information based on dealer information in the dealer database and the received board specification information; and said third computer provides the board specification information to said second computer available for said first dealer, said first dealer handling the circuit board inspection apparatus or the component circuit-board inspection apparatuses which is suitable for inspecting said circuit board.

However Singh discloses said third computer includes a dealer database storing dealer information defined for each of said dealers (0028 and 0031-0032), said third computer determines said first dealer should receive the board

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specification information based on dealer information in the dealer database and the received board specification information (0028, 0031-0032, 0036, 0051, and 0055-0056), said third computer provides the board specification information to said second computer available for said first dealer, said first dealer handling the circuit board inspection apparatus or the component circuit-board inspection apparatuses which is suitable for inspecting said circuit board (0051, 0054, and 0056).

It would be obvious to one skilled in the art at the time the invention was made to modify Doyle and Jardin's method to include said third computer includes a dealer database storing dealer information defined for each of said dealers, said third computer determines said first dealer should receive the board specification information based on dealer information in the dealer database and the received board specification information; and said third computer provides the board specification information to said second computer available for said first dealer, said first dealer handling the circuit board inspection apparatus or the component circuit-board inspection apparatuses which is suitable for inspecting said circuit board as taught by Singh. The motivation to combine streamline procurement

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process, and minimize costs in time, materials, and human effort (0016).

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6. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Doyle et al. U.S. Pat. 5,694,551 (hereinafter Doyle) in view of Jardin U.S. Pat. 6,681,327 (hereinafter Jardin) as applied to claim 1 above, and further in view of Marshall, S. *"It Pays to Shop When Fixing Electronics"* (hereinafter Marshall)

As per claim 28, Doyle and Jardin both fail to explicitly disclose wherein said service information includes at least either one of an inspection cost and inspection time-schedule.

However Marshall discloses wherein said service information includes at least either one of an inspection cost and inspection time-schedule (Section A).

It would be obvious to one skilled in the art at the time the invention was made to modify Doyle and Jardin's method to include discloses wherein said service information includes at least either one of an inspection cost and inspection time-schedule as taught by Marshall. The motivation to combine would allow for a fee to be associated with a service, so that time and effort can be compensated, in a fee, towards the servicer.

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The Examiner notes that these references do not explicitly disclose circuit-board inspection apparatus or a component of a circuit-board inspection apparatus for this information service system. However, the Examiner notes Doyle in view of Jardin (with further in view of Buisness Wire, Cameron, and Marshal) disclose analogous art that solves the general flow of information in an information service system. Even though the claims are directed to circuit-board inspection the invention's actual focus is directed to the flow of information pertaining to a service that can be handled in an information service system. The Examiner interprets that any service could be used in order to implement this information service system. The following references used in this rejection solve the information flow in this particularly disclosed information service system. The prior art used contains analogous features that allow means of receiving or notifying particular computers in a given computer network. Thus, it would have been obvious to create a similar information service system that is analogous for circuit board inspection for the motivation of allowing correct information flow between computers in a given network.

Response to Arguments

7. Applicant's arguments filed 28 April 2006 have been fully considered but they are not persuasive.

With respect to claim 1, the Applicant argues that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the Examiner did provide motivation to combine the teachings of Doyle with Jardin. The Examiner provided the following motivation to combine Jardin; "would provide communication technology to support the brokering of client transactions over a communication network and help aid in eliminating server bottlenecks based off of those client transactions over that communication network (col. 2, lines 49-53)". The Examiner notes that Jardin

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offloads tasks to provide "significant operational advantage (col. 7, lines 20-25)". The Examiner notes Jardin directs these operational tasks to SSL operations, however the Examiner further notes that any operational task can be offloaded. It would be obvious to implement the communication structure (i.e. through the "broker"/third computer) of Jardin to the teachings of Doyle in order to offload any operation task, which in turn would provide significant operation advantage (i.e. operational efficiently). The Examiner did provide a prima facie case of obviousness, motivation was cited, there is reasonable expectation of success, and the references teach or suggest all of the limitations of the claim. Thus the argument is not persuasive.

With respect to claim 3, the applicant argues "Business Wire" fails to disclose "wherein said second computer is available for a second dealer intending to provide an after-sale service." The Examiner disagrees.

"Business Wire" does indeed teach wherein said second computer is available for a second dealer intending to provide an after-sale service (Section A; Examiner

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interprets "Internet-based warranty claim" to be an after-sale service that can be requested via a client computer). The Examiner notes while features of an apparatus may be recited structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (MPEP 2114). The Examiner notes, as a result, the combination of prior art teaches a second computer; who uses said second computer is intended use of said second computer, therefore does not differentiate the present invention from the prior art.

Further, the Examiner notes "Business Wire" discloses after-sale service is "designed to decrease the service requirements placed on its value-added resellers," this being the first dealer. Further the "after-sale service" is provided as an "Internet-based warranty claim processing solution," this being the second dealer (e.g. in "Business Wire; "Minolta Peripheral Products Division"). The Examiner

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did provide a prima facie case of obviousness, motivation was cited, there is reasonable expectation of success, and the references teach or suggest all of the limitations of the claim. Thus the argument is not persuasive.

With respect to claims 4 and 19, the applicant argues Cameron fails to disclose, "means for receiving from the first computer a desired delivery date, desired cost, or desired equipment specification." The Examiner disagrees.

Cameron does indeed teach means for receiving from the first computer a desired delivery date, desired cost, or desired equipment specification (col. 9, lines 22-35). The Examiner notes while features of an apparatus may be recited structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim (MPEP 2114). The Examiner notes, as a result, the combination of prior art

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teach a first computer; what is received by said first computer is intended use of said first computer, therefore does not differentiate the present invention from the prior art.

Further, the Examiner notes Cameron discloses "the user may override the systems determination, if desired (col. 9, lines 32-33)." Further systems determination is based on "shipment carries and shipment service levels." The Examiner interprets "shipment service level" to be a form of delivery based on delivery time (e.g. Overnight Delivery, Next-Day Delivery, Standard, etc). Thus by altering the service level a desired delivery date can be chosen based on "shipment service levels." The Examiner did provide a prima facie case of obviousness, motivation was cited, there is reasonable expectation of success, and the references teach or suggest all of the limitations of the claim. Thus the argument is not persuasive.

With respect to claim 9, the argument is moot based on new grounds of rejection in light of the addition of newly amended limitations.

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With respect to claim 28, the applicant argues Marshall fails to disclose "an information system that fulfills a specific request from a user about information regarding costs for inspection of the users equipment and a time schedule for the inspection."

The Examiner would like to assert that the Examiner combined Doyle with Jardin to teach an information system that fulfills a specific request from a user. The Examiner combined Marshall in order to only provide wherein said service information includes at least either one of an inspection cost and inspection time-schedule (Section A). The Examiner did provide a prima facie case of obviousness, motivation was cited, there is reasonable expectation of success, and the references teach or suggest all of the limitations of the claim. Thus the argument is not persuasive.

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Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. United States Patent 6,324,522 [Electronic Information Network for Inventory Control and Transfer].

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571) 272-1466. The examiner can normally be reached on M-F 8a-4:30p.

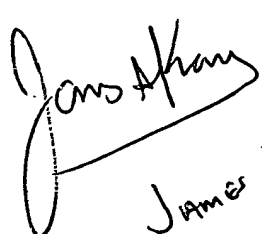
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Asfand M Sheikh
Examiner
Art Unit 3627

ams

 6/26/06
James Keamer